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10/634,146	08/04/2003	Brian G. Johnson	ITO.0549US (P16246)	5099
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TROP PRUNER & HU, PC 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			EXAMINER WEINBERG, MICHAEL J	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/634,146
Filing Date: August 04, 2003
Appellant(s): JOHNSON, BRIAN G.

MAILED

SEP 14 2007

GROUP 2800

Timothy N. Trop, Esq.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/11/2007 appealing from the Office action mailed 3/5/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is used by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, with regard to claim 1 (and depending claims 2-10), there is no teaching or suggestion in the originally-filed specification that optical programming occurs *after* electrical programming.

(10) Response to Argument

The limitation of optical programming *after* electrical programming cannot be discerned from the specification as originally filed. Thus, it constitutes new matter and violates the written description requirement of 35 U.S.C. 112, first paragraph.

The word “after” is nowhere in the specification, nor is there any suggestion of a method comprising optically programming a phase change memory after electrically programming said memory. Furthermore, the drawings only show embodiments of the memory, but do not document any methods performed by the memory.

Appellant has never stated where, in plain language, the limitation at issue is taught in the specification, and the cited pages and lines do not cure this deficiency. Instead, Appellant has repeatedly asserted that the limitation at issue is “necessary” and “must occur”. For example, Appellant states, “Necessarily, to be useable, the memory must be reprogrammed.” However, one would understand that if something is

necessary, than it is needed 100% of the time. This is clearly not the case here. For instance, in some chalcogenide-based storage systems, data is programmed only once (e.g. a CD-R or write-once memory) while others are programmed many times (e.g. a CD-RW or write-many memory). Since, the claimed memory certainly would still function if it were programmed only once, reprogramming is far from "necessary". Appellant even contradicts himself when he admits that light programming after electrical programming is only "necessary [...] in some cases" (Appeal Brief, page 9). While it is not even clear if Appellant's assertion is true, the alleged cases are still not documented in the specification. As a result, one skilled in the art would not clearly identify whether Appellants were in possession of the alleged invention at the time of filing.

Appellant points to page 8, lines 4-11 as teaching optically programming after electrically programming, but, again, there is no such teaching or suggestion for this. The fact that the optical programming is described second in the specification is not a teaching that one method happens after the other. A statement to the contrary is merely conclusory.

Thus, it has not been established that Appellant was in possession of the claimed subject matter at the time of filing.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael Weinberg

Conferees:

Amir Zarabian

David Blum


